

C. REMARKS AND ARGUMENTS

1. Amendments to the Claims

Claims 1, 10, and 25 are currently amended (in sub-paragraph (b) of each claim) to define the read-write chip of each memory button as being sealed inside an armoured container, whereas the previous versions of these claims recited “an armoured container encasing the memory chip”. The wording added in this amendment corresponds to similar wording in [0041] of the specification as originally filed, and therefore this amendment does not introduce new matter.

In ¶ 5 of the Final Action, the Examiner rejected Claims 1, 10, and 25 on the basis that the phrase “in proximity to” in these claims renders them indefinite under 35 U.S.C. § 112, second paragraph. In response to this rejection, Claims 1, 10, and 25 are currently amended to indicate that each memory button is installed “on or in the equipment unit in association with a selected component of the equipment unit” (rather than “in proximity to” a component). The phrase “in association with” is used in the same context in ¶ [0047] of the specification as originally filed, as well as in the abstract, and therefore this amendment does not introduce new matter. Applicant submits that the phrase “in association with” is not indefinite, and, therefore, that the current amendments to Claims 1, 10, and 25 satisfactorily address the rejection in ¶ 5 of the Final Action.

2. Other Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

In ¶ 4 of the Final Action, the Examiner rejected Claims 1, 10, and 25 under 35 U.S.C. § 112, second paragraph, on the basis that these claims recite inoperable subject matter – specifically, a read-write memory chip having an unalterable identification number. The Examiner suggests that this is impossible, and on that basis the Examiner interpreted this limitation, for examination purposes, as a read-write memory chip only. Applicant respectfully traverses this rejection.

Filed concurrently herewith is an Information Disclosure Statement and a copy of the non-patent reference cited therein – i.e., “Cryptographic Module Security Policy for the Dallas Semiconductor DS1954B Crypto iButton™” (the “DSC reference”) published

by Dallas Semiconductor Corporation on August 16, 1999 (available online at <http://csrc.nist.gov/cryptval/140-1/140sp/140sp101.pdf>). It will be noted that the specification herein refers (at ¶ [0041]) to Dallas Semiconductor's "iButtons" as examples of read/write memory buttons with unique and unalterable identification numbers recorded directly onto the chips enclosed therein. The DSC reference discloses a memory button having a read/write chip (see sub-¶ 2.3 at p. 7 of the DSC reference) having a unique and unalterable registration number lasered into the chip's read-only memory (see sub-¶ 2.1 at pp. 4-5). The DSC reference thus establishes that a read-write memory chip having an unalterable identification number was in fact known and commercially available prior to the effective filing date of the present application. Accordingly, Applicant submits that the DSC reference fully answers and rebuts the rejection in ¶ 4 of the Final Action.

3. **Claim Rejections Under 35 U.S.C. § 102**

In ¶¶ 7-12 of the Final Action, the Examiner rejected Claims 1-7, 9-16, 18, and 20-25 as being anticipated by Yacoob (USPN 6,170,742), on the basis that Yacoob discloses a method having all the limitations of Claims 1 and 10 including:

- a portable computing device having a memory and a user interface whereby a user may enter user-defined data and commands into said memory; and
- a memory button comprising:
 - a read-write memory chip, said memory chip having stored therein a unique and unalterable identification number; and
 - an armoured container encasing the memory chip and comprising contact means electrically connected to the memory chip.

Applicant respectfully traverses this rejection based on the submissions set out below.

"Portable computing device"

With respect to the "portable computing device", the Examiner states in ¶ 21 that Yacoob discloses a portable computing device in the form of a computer which is onboard a motor vehicle. The examiner suggests that this feature from Yacoob

reads on the portable computing device of Claims 1 and 10 on the basis that the vehicle in Yacoob can move, thus rendering the vehicle's onboard computer "portable". Applicant respectfully submits that this analysis is premised on an overly broad interpretation of the word "portable" as used in the claims, having regard to the principles set out in MPEP § 2111 (as summarized in the following paragraph).

For purposes of examination, claims in a patent application must be given their broadest reasonable interpretation consistent with the specification. The words in a claim are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art, and it is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the ordinary and the customary meaning of the claim terms. The ordinary and customary meaning of claims terms may be evidenced from extrinsic reference sources such as dictionaries. If such sources evidence more than one definition of a claim term, the intrinsic record must be used to identify which of the different possible definitions is most consistent with applicant's use of the terms. Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.

With the foregoing principles in mind, it is submitted that the only reasonable interpretation of the term "portable computing device" consistent with the specification, and which reflects the ordinary and customary meaning of the words used in the term, is a computing device capable of being physically carried by an individual (i.e., a user of the invention). As consistently used in the specification (see ¶¶ [0048] to [0053]), the term "portable computing device" suggests nothing *other* than a computing device that a user of the invention can carry on his or her person to and at the point at which an inspection or maintenance task is to be carried out.

This is necessarily the only reasonable interpretation in the context of the specification; otherwise the claimed invention would be inoperable. This becomes particularly clear upon review of ¶ [0053] of the specification, the first two sentences of which read as follows:

"In the preferred embodiment, a technician in the field will thus have direct access to the Internet, thereby obtaining a number of practical benefits. In addition to having access to technical and historical information in the central database, the technician may search other helpful resources accessible via the Internet, directly and conveniently from the portable computing device 24 which the technician has during inspection or maintenance work, even if such work is being carried out from high on a scaffold or some other unusual position." [Emphasis added]

This passage indicates that a user of the invention (e.g., a "technician") has the portable computing device with him or her when using the invention ("in the field") to carry out inspection or maintenance work, regardless of where that work is being done, and high scaffolding is given as an example of where such work might be done. There can be not doubt, having regard to this passage, that the portable computing device of the invention must be portable in the sense that it is capable of being physically carried by an individual; otherwise, the user logically could not have it available at the point of inspection or maintenance work regardless of the location of the work.

On the foregoing basis, Applicant submits that a person of ordinary skill in the art, having regard to the specification, would interpret the term "portable computing device" as connoting a computing device capable of being physically carried by an individual. Applicant further and respectfully submits that there is no basis presently in evidence on which it could be reasonably suggested that a person of ordinary skill might interpret the term as having a different meaning.

Applicant's suggested interpretation of the term "portable computing device" is also consistent with common dictionary meanings of the word "portable", examples of which are set out below:

Per Merriam-Webster's Collegiate Dictionary, 11th Edition

- 1a: "capable of being carried or moved about {[e.g.] a [portable] TV}"

Per New Oxford American Dictionary (New York: Oxford Univ. Press, 2001)

- adj. "able to be easily carried or moved, esp. because of being a lighter and smaller version than usual: *a portable television.*"
- n. "a version of something, such as a small lightweight television or computer, that can be easily carried."

(Relevant excerpts from the cited dictionaries are enclosed with this submission.)

On the foregoing basis, Applicant submits that a person of ordinary skill in the art of the invention would not reasonably interpret the "portable computing device" limitation so broadly as to cover the onboard computer of Yacoob, and that this limitation should be construed for examination purposes as connoting a computing device that is capable of being physically carried by an individual.

"Memory button" comprising "armoured container"

In ¶ 7 of the Final Action, the Examiner states that Yacoob discloses a memory button comprising a memory chip in an armoured container. This statement appears to be based on a construction of the term "armoured container" pursuant to which the vehicle in which the onboard computer of Yacoob is installed would read on the armoured container of the claimed invention. Applicant respectfully submits that this construction of "armoured container" is overly broad having regard to the specification and claims. Bearing in mind that the claims call for the memory button – with its "armoured container" – to be installed on or in an equipment unit, it would be clearly unreasonable to consider the automobile-encased memory chip of the computer of Yacoob as reading on the memory button of the claims herein.

The unreasonableness of such an interpretation is further apparent from the fact that the "armoured container" is defined as a component of the memory button. The specification does not set out a specific meaning for the word "button", so it

is appropriate to consult extrinsic references to determine the ordinary and customary meaning of the word. Exemplary dictionary meanings of the word "button" are set out below:

Per Merriam-Webster's Collegiate Dictionary, 11th Edition

- 1a: "a small knob or disk secured to an article (as of clothing) and used as a fastener . . . [.]"
- 1b: "a [usually] circular metal or plastic badge bearing a stamped design or printed logo {[e.g.] campaign [button]}"
- 2: "something that resembles a button . . . [.]"

Per New Oxford American Dictionary (New York: Oxford Univ. Press, 2001)

- n. "a small disk or knob sewn on to a garment . . . [.]"
- n. "a knob on a piece of electrical or electronic equipment . . . [.]"
- n. "a small round object resembling a button . . . [.]"

Relevant excerpts from the cited dictionaries are enclosed with this submission.

Having regard to these exemplary dictionary definitions, it can be deduced that the word "button" is commonly and ordinarily understood to connote an item such as a disc or knob having the primary characteristic of being small. Although "small" is a relative term, the dictionary definitions of "button" put the "smallness" of the button in a reasonably definite context -- i.e., in the sense of "something that resembles a button" (e.g., "a small knob or disk") or "a small [round] object resembling a button". If the memory button is thus understood as being "small" in the sense that a clothing button or electrical button is small, and if the armoured container is a component of the button (as the claims define it to be), then the armoured container must be similarly small. It logically follows, therefore, that the "memory button" of the claimed invention could not be reasonably interpreted, and would not be understood by a person of ordinary skill in that art, as extending to something as large as a vehicle enclosing a memory chip (in an onboard computer).

On the foregoing basis, Applicant submits that a person of ordinary skill in the art of the invention would not reasonably interpret or understand the memory button and armoured container of the claimed invention in such broad terms as to read on by Yacoob's vehicle having an onboard computer. The only interpretation reasonably consistent with the specification (and in particular the reference therein to the Dallas Semiconductor iButton™) would be that the armoured container is a "small" item, in the sense of "something that resembles a button [e.g., a small knob or disk]" or "a small [round] object resembling a button". Applicant further and respectfully submits that there is no basis presently in evidence on which it could be reasonably suggested that a person of ordinary skill might interpret the term as having a different meaning.

Based on the foregoing analysis, Applicant respectfully submits that the Yacoob reference does not disclose the "portable computing device" and "memory button" of the present invention, as those limitations would be reasonably understood by a person of ordinary skill in the art, and, accordingly, that the claimed invention is not anticipated by Yacoob. To further distinguish the memory button of the invention from the allegedly analogous component from Yacoob, Claims 1, 10, and 25 are currently amended to indicate that the memory chip of the memory button is sealed inside the armoured container (per ¶ C.1 herein).

4. Claim Rejections Under 35 U.S.C. § 103

Obviousness based on Yacoob

In ¶¶ 14-15 of the Final Action, the Examiner rejected Claims 8, 17, and 19 as being obvious in view of Yacoob. Applicant respectfully submits that this issue has been rendered moot by virtue of the present amendments and arguments in connection with independent Claims 1 and 10; i.e., if Claims 1 and 10 are not obvious in view of Yacoob, dependent Claims 8, 17, and 19 likewise are not obvious in view of Yacoob.

Obviousness based on Fieramosca in view of Flicker

In ¶¶ 16-18 of the Final Action, the Examiner rejected Claims 1-20 as being obvious over the Fieramosca reference in view of the Flicker, Jr. references, on the same grounds stated in the non-final action dated December 23, 2004. Applicant respectfully traverses this rejection.

In ¶ 20 of the Final Action, the Examiner paraphrases Applicant's argument on this point (as stated in the response filed April 16, 2005) as being to the effect that Flicker in view of Fieramosca does not disclose storage or retrieval of user-definable inspection and maintenance information. In connection with this point, the Examiner states (in ¶ 23 of the Final Action) that "the recitation 'accessing and storing data pertaining to inspection and maintenance of an equipment unit' has not been given patentable weight because the recitation occurs in the preamble."

While it is true that each independent claim includes a preambular reference to "accessing and storing" or "storing and retrieving" inspection and maintenance information regarding an equipment unit, the body of each independent claim also recites a user interface whereby a user may enter user-defined data and commands into the memory of the portable computer. Accordingly, patentable weight should be given to the limitations in the body of the claims referring to storage and retrieval of user-defined information. Applicant respectfully restates and relies on his earlier-stated position (per the submissions filed on April 16, 2005) that neither Flicker nor Fieramosca discloses or suggests either storage or retrieval of user-defined information on the equipment unit. As well, neither Flicker nor Fieramosca discloses or suggests locating one or more memory buttons in or on an equipment unit in association with selected components of the equipment unit, as in the present invention.

On the foregoing basis, Applicant submits that none of the claims in the application are obvious having regard to Fieramosca in view of Flicker, as each of the pending claims incorporates limitations not disclosed or suggested in either Fieramosca or Flicker. Accordingly, a *prima facie* case of obviousness has not been established, having regard to the criteria set out in MPEP § 706.02(j).

5. Amended Claims are Allowable

On the basis of the foregoing remarks, Applicant respectfully submits that amended independent Claims 1, 10, and 25 are all allowable. It follows, therefore, that dependent Claims 2-9 and 11-24 are allowable as well.

D. CONCLUDING REMARKS

Applicant respectfully submits that the current amendments fully and satisfactorily address all issues raised in the Final Action, and that the application will be in condition for allowance upon entry of the amendments. Accordingly, Applicant requests timely issuance of a Notice of Allowance.

Respectfully submitted on behalf of the Applicant,
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Enclosures

1. Request for Continued Examination [1 sheet];
2. Credit Card Payment Form PTO-2038 re RCE filing fee [1 sheet];
3. Information Disclosure Statement [1 sheet] with copy of cited reference [17 pp.];
4. Excerpts from Merriam-Webster's Collegiate Dictionary, 11th Edition [4 pp.]; and
5. Excerpts from New Oxford American Dictionary [4 pp.].